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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,900	11/10/2000	John J. Gabrick	MINMAT.P01	3638
47022	7590	09/06/2006	EXAMINER	
THE LAW OFFICE OF RICHARD W. JAMES 25 CHURCHILL ROAD CHURCHILL, PA 15235			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/709,900	<b>Applicant(s)</b> GABRICK ET AL.	
	<b>Examiner</b> Mary Cheung	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-18 and 20-57 is/are pending in the application.
- 4a) Of the above claim(s) 20-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Application***

1. This action is in response to the restriction election filed June 19, 2006. Claims 8-18 and 20-57 are pending. Claims 1-7 and 19 are canceled. Claims 8-18 are elected for examination. Claims 20-57 are not elected, and thus are withdrawn from consideration.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 8-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

3. Claim 8 is objected to because of the following informalities: the applicant is advised to clearly point out that the modules comprise computer hardware components because if the modules are software pro se, the claim would direct to non-statutory subject under 35 U.S.C. §101 (see MPEP 2106 IV B 1). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 8, it is not clear how the limitation "exploitation of intellectual property" is related to the innovator various types of modules.

Claims 9-18 are rejected for incorporating the errors of their respective base claim 8 by dependency.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asplen, Jr., U. S. Patent 6,044,354 in view of Ziff et al., U. S. Patent 6,557,013.

As to claim 8, Asplen teaches a system for development and exploitation IP, the system comprising (abstract and Fig. 1A):

- a) An innovator attraction module (column 2 lines 45-52 and Fig. 1A);
- b) A developer attraction module (column 2 line 64 – column 3 line 35 and Fig. 1A);
- c) A registration module (column 2 lines 49-58 and Fig. 1A);
- d) A match module (column 3 lines 10-27 and Fig. 1A);

the registration module to accept data related to an innovator and the innovator's innovation and to store the data in an innovation database (column 2 lines 49-60 and Figs. 1 and 1A), and the match module to match the innovation and the innovator with a developer (column 2 line 59 – column 3 lines 9 and Fig. 1A).

Asplen does not specifically teach the system is a web-based development. However, Asplen teaches the system uses LAN, WAN, Internet, and emails (column 2

lines 2-14), and Ziff teaches using web-based system for developing writing assignment (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system in Asplen's teaching to be a web-based development since the Asplen's already use the internet for developing innovated ideas; in addition, by enhancing the system with the web-based technology, it would allow the innovated ideas to be fast and easily processed.

As to claim 9, Asplen teaches the innovation database is operably stored for random retrieval on a storage medium (column 2 lines 49-60 and Figs. 1 and 1A).

As to claim 10, Asplen teaches updating and changes to the data are also stored in the innovation database (column 6 lines 15-18).

As to claim 11, Asplen teaches the match module is to match one or more other innovations with one or more other developers (column 2 line 45 – column 3 line 35 and Figs. 1 and 1A).

As to claim 12-18, Asplen teaches a tracking module to make available to a user at least one of a status and an outcome of any activity related to the matching of the innovation and the innovator with the developer (column 2 lines 2-14 and column 3 lines 18-35 and column 5 lines 54-67 and Figs. 1 and 1A).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 8-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 09/687,510. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose a system for web based development and exploitation intellectual property.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer, can be reached on (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300	(Official Communications; including After Final Communications labeled "BOX AF")
(571) 273-6705	(Draft Communications)

Mary Cheung  
August 30, 2006

MARY D. CHEUNG  
PRIMARY EXAMINER

